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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91201361
Party	Defendant C4G Holdings, LLC
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Submission	Motion to Dismiss 2.132
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Signature	/Hara K. Jacobs/
Date	11/19/2013
Attachments	Motion for Dismissal Opposition No 91201361.pdf(158806 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

CONNECTICUT GOLD BUYERS, LLC, and  
JOSEPH R. CANDELLA

Opposers,

v.

C4G HOLDINGS, LLC and GREEN BULLION  
FINANCIAL SERVICES, LLC,

Applicants.

Opposition No.:

91201361

Mark:

ORIGINAL CASH4GOLD SITE

**APPLICANT'S MOTION FOR DISMISSAL PURSUANT TO 37 C.F.R. § 2.132**

Applicant, C4G Holdings, LLC<sup>1</sup> ("C4G" or "Applicant"), by its undersigned counsel, hereby moves for dismissal of the Opposition filed by Opposers Connecticut Gold Buyers, LLC and Joseph R. Candella (collectively, "Opposers") because Opposers did not take any testimony during the testimony period and, in fact, have never taken any steps to prosecute this Opposition in any way.

**I. STATEMENT OF FACTS**

On August 26, 2011, Opposers filed a Notice of Opposition to the mark ORIGINAL CASH4GOLD SITE, originally filed by Green Bullion Financial Services, LLC ("Green Bullion"). (Notice of Opposition, Dkt. No. 1.) Green Bullion timely filed its Answer on September 22, 2011. (Applicant's Answer, Dkt. No. 4.) The Board temporarily suspended the proceedings on March 14, 2012 and, following the assignment of the mark from Green Bullion

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<sup>1</sup> On December 26, 2012, C4G recorded an assignment of the mark that is the subject of this Opposition (Application Serial No. 77/592,427) from the original Applicant Green Bullion Financial Services, LLC to C4G. (See Trademark Assignment Database at Reel/Frame: 4928/0619.) Accordingly, the Board joined C4G in this proceeding.

to C4G, the Board resumed the proceedings on December 26, 2012. (*See* Dkt. Nos. 6–8.) The Board's Order resuming the proceedings set new deadlines, including the deadline for Opposers' pre-trial disclosures on September 29, 2013, and the close of Opposers' testimony period on November 13, 2013. (Board Order, Dkt. No. 8.)

During the course of this Opposition, Opposers did nothing to prosecute their Opposition. (Declaration of Hara K. Jacobs, Esq. at ¶2, attached as Exh. A hereto.) Opposers took no discovery of any kind. (*Id.* at ¶ 3.) Opposers took no testimony during the testimony period and did not file a Notice of Reliance. (*Id.*) Opposers did not serve pretrial disclosures. (*Id.*) Indeed, Opposers' counsel never once communicated with Applicant's counsel concerning this Opposition proceeding. (*Id.* at ¶¶ 3–4.)

This is not the first time that Opposers have filed an opposition to the CASH4GOLD marks but did nothing to prosecute their opposition. Indeed, in 2010, Opposers filed oppositions against three CASH4GOLD marks filed by Green Bullion ("the 2010 Oppositions"). *See Conn. Gold Buyers, LLC v. Green Bullion Fin. Servs., Inc.*, TTAB November 26, 2011 at p. 1 (attached as Exh. B hereto). After Opposers failed to prosecute the 2010 Oppositions in any way, on August 19, 2011, Green Bullion filed a motion to dismiss pursuant to 37 C.F.R. § 2.132. *Id.* at 2. Seven days later, on August 26, 2011, Opposers instituted the present Opposition and filed a cross-motion to consolidate this Opposition with the 2010 Oppositions. *Id.* at 2–3. The Board denied Opposers' cross-motion to consolidate and granted Applicant's motion to dismiss the 2010 Oppositions. (*Id.* at 7.) The Board explained that the record did not support Opposers' "failure to act," the delay "was within their control, and [that] the delay's length and impact on this proceeding establish[ed] that opposers' failure to take

testimony or submit evidence during their testimony period [wa]s not excusable." (*Id.* at pp. 5–7).

## **II. LEGAL ARGUMENT**

The Opposition should be dismissed with prejudice and judgment should be entered in C4G's favor because Opposers failed to take testimony during the testimony period and Opposers cannot demonstrate good and sufficient cause for their failure to do so *for a second time*.

Pursuant to Trademark Rule 2.132(a), when a party in the position of plaintiff fails to take testimony during the time allowed, judgment will be entered against it in the absence of a showing of good and sufficient cause. 37 C.F.R. § 2.132(a). To satisfy the "good and sufficient" cause standard, Opposers must show that their failure to take testimony constituted excusable neglect. *PolyJohn Enterprises Corp. v. 1-800-Toilets Inc.*, 61 U.S.P.Q. 2d 1860, 1860 (TTAB 2002); *see also* 37 C.F.R. § 2.132 (a); TBMP § 534.02 (3d ed. 2011); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 U.S.P.Q. 2d 1848, 1852 (TTAB 2000) ("Pursuant to Fed. R. Civ. P. 6(b)(2), the requisite showing for reopening an expired period is that of excusable neglect."). In the context of a party who fails to take testimony, the Board will determine whether the party's neglect is excusable by taking into consideration all relevant circumstances including: (1) prejudice to the movant; (2) the length of the delay and its impact on the proceedings; (3) the reason for the delay, including whether it was in the reasonable control of nonmovant; and (4) whether the nonmovant acted in good faith. *Baron Philippe de Rothschild*, 55 USPQ2d at 1852; *Pumpkin Ltd. v. The Seed Corps*, 43 U.S.P.Q. 2d 1582 (TTAB 1997). The most important factor is the third factor and it requires the nonmoving party to show that its failure to act was not due to circumstances within its reasonable control. *Pumpkin*, 43 U.S.P.Q. 2d at 1586 n.7; *P22 Type Foundry, Inc. v. Berthold Types Ltd./Berthod LLC*,

Cancellation No. 92045530 (TTAB July 18, 2007) at 5, *available at* <http://ttabvue.uspto.gov/ttabvue/v?pno=92045530&pty=CAN&eno=9> (attached as Exh. C hereto.) By bringing an Opposition, Opposers take responsibility for moving forward on the established schedule, and in each opposition it is incumbent upon Opposers to seek any necessary extensions of time before the close of their testimony period. *See, e.g., Atlanta-Fulton County Zoo Inc. v. DePalma*, 45 U.S.P.Q. 2d 1858, 1860 (TTAB 1998).

Application of the four factors to this case compels the conclusion that Opposers' neglect is inexcusable, requiring dismissal of the Opposition proceeding. The first and second factors—prejudice to C4G and length of delay—weigh heavily in favor of C4G because Opposers' bad faith conduct has already delayed the issuance of the registration for the mark ORIGINAL CASH4GOLD SITE for well over two years. Permitting Opposers, who took no discovery, did not serve pretrial disclosures, and never prosecuted their case in any way, to further delay C4G's trademark registration would further reward Opposers for their bad faith and inexcusable conduct.

The third factor—whether Opposers' failure to take testimony was within their control—proves that Opposers' neglect is inexcusable. Opposers previously engaged in the identical dilatory conduct in connection with multiple applications for the CASH4GOLD mark. In 2010, Opposers opposed three applications by Green Bullion for the CASH4GOLD mark. *See Conn. Gold Buyers* at p. 1 (attached as Exh. B hereto.) Opposers never took discovery, never took testimony, and when Green Bullion filed a motion to dismiss, Opposers further delayed the proceedings by attempting to consolidate those proceedings with the instant Opposition. *Id.* at p. 2–4. The Board granted Green Bullion's motion to dismiss and denied Opposers' motion to consolidate explaining that Opposers' delay "was within their control, and [that] the delay's

length and impact on this proceeding establish[ed] that opposers' failure to take testimony or submit evidence during their testimony period [wa]s not excusable." *Id.* at p. 6–7. Having already fully briefed and lost a motion to dismiss for Opposers' failure to take testimony in earlier proceedings, Opposers cannot demonstrate excusable neglect with what is now their well-established historical pattern of inexcusable dilatory conduct.

The final factor—Opposers' bad faith—is indisputably established by Opposers' repeated and continual filing of baseless Opposition proceedings with no intent to litigate those proceedings for the purpose of delaying the issuance of registrations for the CASH4GOLD mark.

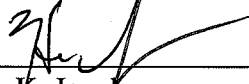
As the Board has recognized, "[a] plaintiff's failure to take testimony in Board proceedings is analogous to not showing up in court on the day of trial." *P22 Type Foundry, Inc.*, (TTAB July 18, 2007) at 8 (attached as Exh. C hereto.) Opposers' failure to show up on the day of trial in this Opposition is unconscionable because the Board previously admonished Opposers for failing to take testimony in three other Oppositions and now Opposers have done it again.

### **III. CONCLUSION**

For all the foregoing reasons, C4G respectfully requests that the Board dismiss the Opposition with prejudice. Additionally, C4G requests that the Board suspend the proceedings pending the disposition of C4G's Motion for Dismiss.

Dated: November 19, 2013

Respectfully submitted,



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Hara K. Jacobs

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*Attorneys for Applicant C4G Holdings, LLC*


**CERTIFICATE OF SERVICE**

I, Hara K. Jacobs, hereby certify that on today's date, I caused a copy of the foregoing Motion for Dismissal to be served by First Class Mail on the Opposers as set forth below:

Marshall J. Touponse  
49 Heminway Park Road  
Watertown, CT 06795

*Attorney for Opposers  
Connecticut Gold Buyers, LLC and  
Joseph R. Candella*

Dated: November 19, 2013

  
\_\_\_\_\_  
Hara K. Jacobs



# EXHIBIT A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

CONNECTICUT GOLD BUYERS, LLC, and  
JOSEPH R. CANDELLA

Opposers,

v.

C4G HOLDINGS, LLC and GREEN BULLION  
FINANCIAL SERVICES, LLC,

Applicant.

Opposition No.:

91201361

Mark:

ORIGINAL CASH4GOLD SITE

**DECLARATION OF HARA K. JACOBS, ESQ.**

I, Hara K. Jacobs, declare as follows:

1. I am a partner in the law firm of Ballard Spahr LLP, current counsel for the owner of the mark ORIGINAL CASH4GOLD SITE, C4G Holdings, LLC ("C4G"), and former counsel for Applicant Green Bullion Financial Services, LLC in the above-referenced proceeding. I submit this Declaration in support of C4G's Motion for Dismissal Pursuant to 37 C.F.R. § 2.132.


2. Opposers Connecticut Gold Buyers, LLC and Joseph R. Candella (collectively, "Opposers") have failed to prosecute the above-captioned Opposition proceeding in any way.

3. After instituting the Opposition proceeding against the mark ORIGINAL CASH4GOLD SITE, Opposers took no discovery of any kind, did not serve pretrial disclosures, presented no testimony during the testimony period, nor did they file a Notice of Reliance.

4. Opposers' counsel never once communicated with me concerning this Opposition proceeding.

I declare, under penalty of perjury, that the foregoing is true and correct.

Dated: Philadelphia, Pennsylvania  
November 19, 2013

  
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Hara K. Jacobs

# EXHIBIT B

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

MBA

Mailed: November 26, 2011

Opposition No. 91195438

Opposition No. 91195439

Opposition No. 91195661

Connecticut Gold Buyers, LLC  
and Joseph R. Candella

v.

Green Bullion Financial  
Services, Inc.

**Before Bucher, Kuhlke and Taylor, Administrative Trademark  
Judges**

**By the Board:**

Applicant seeks registration of the marks OFFICIAL CASH4GOLD SITE, AUTHENTIC CASH4GOLD SITE and ORIGINAL CASH4GOLD SITE, each in standard characters, and each for "precious metal refining."<sup>1</sup> In their notices of opposition to registration of these marks (the "2010 Oppositions"), opposers allege prior use of CASH4GOLD for "buying and refining gold and other precious metals," and that use of applicant's marks would be likely to cause confusion with

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<sup>1</sup> Application Serial Nos. 77977644, 77977759 and 77977780, respectively, each filed October 14, 2008. The application for registration of OFFICIAL CASH4GOLD SITE is based on first use dates of May 31, 2008, and the other two applications are based on applicant's bona fide intent to use the marks in commerce.

Opposition Nos. 91195438, 91195439 and 91195661

opposers' mark.<sup>2</sup> In its answers, applicant denies the salient allegations in the 2010 Oppositions. Pursuant to the Board's order of September 10, 2010, opposer's testimony period in the 2010 Oppositions closed on August 9, 2011.

On the same day it filed its applications involved in the 2010 Oppositions, applicant filed applications to register the same three marks for "scrap dealerships in the field of scrap gold, silver and platinum." Opposers filed additional notices of opposition against these application Serial Nos. 77592301, 77592427 and 77592468, in Opposition Nos. 91200848, 91201361 and 91201387, respectively (the "2011 Oppositions"). Opposers filed the 2011 Oppositions during and after their testimony period in the 2010 Oppositions.

This case now comes up for consideration of applicant's fully-briefed motion, filed August 19, 2011, to dismiss all three of the 2010 Oppositions for failure to prosecute under Trademark Rule 2.132(a). In support of its motion, applicant points out that "the **only** action that Opposers took during the testimony period was to institute a new Opposition proceeding against Applicant's second application

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<sup>2</sup> Opposers also allege in Opposition No. 91195438 that applicant "has never used" its involved mark, and according to the Electronic System for Trademark Trials and Appeals ("ESTTA") form for opposers' notices of opposition, opposers may have also intended to plead other grounds for opposition.

Opposition Nos. 91195438, 91195439 and 91195661

to register its OFFICIAL CASH4GOLD SITE mark" (emphasis supplied).

In response, opposers claim that based on the parties' 2010 discussions about consolidating the 2010 Oppositions, "it was the understanding of the Opposers' counsel" that after opposers filed the 2011 Oppositions, "those opposition proceedings would also be consolidated with" the 2010 Oppositions. Opposers do not explain the basis, if any, for their counsel's belief, and their assertions are not supported by declaration testimony or any other evidence. In any event, opposers contacted applicant on August 19, 2011, i.e., after the close of their testimony period, and "expected to obtain consent from the Applicant's counsel to a consolidation of the 2011 Oppositions with" the 2010 Oppositions. According to opposers, this would result in a resetting of their testimony period in the 2010 Oppositions.

Opposers also cross-move, without applicant's consent, to consolidate the 2011 oppositions with the 2010 Oppositions, and to "utilize the schedule set by the TTAB for the last of the 2011 Oppositions." Opposers argue that "[t]his will be the most efficient means of resolving the entire 'CASH4GOLD' registration dispute at one time," because if the six proceedings are not consolidated and opposers' testimony period in the 2010 Oppositions is not reopened, opposers will "litigate the 2010 Oppositions as

Opposition Nos. 91195438, 91195439 and 91195661

cancellation proceedings after those marks have been registered."

In reply, applicant claims that "Opposers had no basis to assume that these consolidated proceedings would be consolidated with potential future opposition proceedings that did not yet exist." In fact, one of applicant's attorneys testifies that "[i]n consenting to the consolidation of the [2010] Oppositions, there was no discussion of consolidating future opposition proceedings that were non-existent as of July 20, 2010." Declaration of Steven D. Kim ¶ 5.

"Inasmuch as [applicant] has filed a motion for judgment under Trademark Rule 2.132(a), and since [opposers] did not file a timely motion to extend [their] testimony period," dismissal is appropriate unless opposers establish that their failure to take testimony or submit other evidence was the result of "excusable neglect." PolyJohn Enterprises Corp. v. 1-800-Toilets Inc., 61 USPQ2d 1860, 1860 (TTAB 2002); see also, Trademark Rule 2.132(a); TBMP § 534.02 (3d ed. 2011); Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co., 55 USPQ2d 1848, 1852 (TTAB 2000) ("Pursuant to Fed. R. Civ. P. 6(b)(2), the requisite showing for reopening an expired period is that of excusable neglect."). As the Board stated in Baron Philippe:

In Pioneer Investment Services Company  
v. Brunswick Associates Limited



Partnership, 507 U.S. 380, 395 (1993), the Supreme Court set forth four factors to be considered in determining excusable neglect. Those factors are: (1) the danger of prejudice to the non-moving party; (2) the length of delay and its potential impact on judicial proceedings; (3) the reason for the delay, including whether it was within the reasonable control of the moving party; and, (4) whether the moving party has acted in good faith. In subsequent applications of this test by the Circuit Courts of Appeal, several courts have stated that the third factor may be considered the most important factor in a particular case. See Pumpkin Ltd v. The Seed Corps, 43 USPQ2d 1582, 1586 at fn. 7 (TTAB 1997).

Baron Philippe de Rothschild, 55 USPQ2d at 1852. Here, opposers have not even alleged, much less established, excusable neglect.

In fact, even if opposers attempted to argue that their failure to act was the result of excusable neglect, the record would not support the claim. Turning to the third factor first, the record reveals nothing outside of opposers' reasonable control which prevented them from introducing evidence or seeking an extension of time in which to do so. To the contrary, and as applicant points out, opposers filed two of the 2011 Oppositions during their testimony period in the 2010 Oppositions, evidencing that opposers were able to file materials with the Board during their testimony period. And if opposers believed that the 2010 Oppositions would or should be consolidated with the 2011 Oppositions, it was incumbent upon

Opposition Nos. 91195438, 91195439 and 91195661

them to file a motion to consolidate and seek any necessary extensions of time before the close of their testimony period in the 2010 Oppositions. Indeed,

Opposer[s] brought this case and, in so doing, took responsibility for moving forward on the established schedule. As required by the scheduling order, as reset, opposer[s] had an obligation to take testimony or otherwise introduce evidence in furtherance of [their] claim by [August 9, 2011], or, alternatively, to file, on or prior to that date, a motion to extend [their] testimony period.

Atlanta-Fulton County Zoo Inc. v. DePalma, 45 USPQ2d 1858, 1860 (TTAB 1998). This factor weighs heavily against a finding of excusable neglect.

The remaining factors are of no help to opposers. With regard to the length of the delay and its potential impact on this almost one and one-half year old proceeding, while the delay is not extraordinary, it is not insignificant either. There is no evidence that opposers acted in bad faith, or in good faith, and this factor is therefore neutral. While there is no evidence of prejudice to applicant, weighing all of the factors together, to the extent that this factor weighs in opposers' favor, it is not sufficient to outweigh the other factors. To the contrary, the reason for opposers' delay, which was within their control, and the delay's length and impact on this proceeding establish that opposers' failure to take

Opposition Nos. 91195438, 91195439 and 91195661

testimony or submit evidence during their testimony period is not excusable. Therefore, we find that opposers have not shown excusable neglect.

In an opposition proceeding, an opposer bears the burden of proving both its standing to oppose and at least one valid ground for refusal of registration. Because opposers' testimony period has expired and opposers have not taken testimony or offered any evidence, we find that opposers have not proven either their standing or a ground for refusal. Accordingly, applicant's motion to dismiss is hereby **GRANTED**, opposer's cross-motion to consolidate is hereby **DENIED** and Opposition Nos. 91195438, 91195439 and 91195661 are hereby dismissed with prejudice pursuant to Trademark Rule 2.132(a).

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# EXHIBIT C

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Butler

Mailed: July 18, 2007

Cancellation No. 92045530

P22 TYPE FOUNDRY, INC.

v.

BERTHOLD TYPES LTD./BERTHOD LLC

Before Bucher, Holtzman and Mermelstein, Administrative Trademark Judges.

By the Board:

In accordance with the institution order dated March 3, 2006, petitioner's first testimony period closed on December 18, 2006. This case now comes up on respondent's fully briefed motion, filed January 11, 2007, for involuntary dismissal pursuant to Trademark Rule 2.132(a), 37 C.F.R. 2.132(a).<sup>1</sup>

In support of its motion, respondent argues that petitioner has not taken any testimony or offered any other evidence in this case.

In response, petitioner argues that its omission arose from a series of events beginning with communications initiated by respondent with the apparent intent to amicably resolve this trademark registration dispute compounded by unexpected technical

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<sup>1</sup> Petitioner's consented motion, filed January 22, 2007, for an extension of time to file its response to respondent's motion for involuntary dismissal is granted. See Fed. R. Civ. P. 6(b)(1).

failures encountered as a consequence of the relocation of the office of petitioner's attorney. As background, petitioner indicates that shortly after commencing this cancellation proceeding its attorney was contacted by respondent's president to discuss settlement;<sup>2</sup> that petitioner prepared and forwarded a proposed settlement agreement; that a response, including a proposed amended settlement agreement, was received from one of respondent's principals whom petitioner believed was in-house counsel; and that telephone communications took place as well. Petitioner also notes that it served responses to respondent's discovery requests in mid-May 2006, though it delayed serving its own requests.

Petitioner's attorney states that he relocated his office May, 25 2006; that the relocation required about 35 days; that during this time period he experienced construction delays, computer crashes, and technical mishaps with the firewalls, data wiring, servers, and computer and telephone systems; and that the technical difficulties involved corruption of data files,

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<sup>2</sup> Petitioner also recounts its difficulty in commencing a cancellation proceeding against the involved registrations. According to petitioner, its first petition to cancel, filed April 5, 2005, was either lost or misdirected. Petitioner refiled on March 3, 2006, resulting in the commencement of the instant action. In the meantime, petitioner was trying to remedy the problem with the first filing. Petitioner supports its experiences, in part, with copies of post cards with USPTO receipt dates stamped thereon and written correspondence with Board personnel. The Board instituted a duplicate cancellation proceeding, No. 92045583, which was eventually dismissed as a duplicate.

While petitioner's experiences in commencing this proceedings are no doubt regrettable, they are not relevant to its failure to take testimony or submit evidence during its assigned testimony period, scheduled approximately nine months after the commencement of this proceeding.

including those related to the docketing software. Petitioner notes that the various systems became inoperative or required repairs and that "they had to be partially reconstituted and errors arose." Petitioner indicates it acted promptly upon learning of the delay by contacting opposing counsel to seek an extension to file its response to respondent's motion.<sup>3</sup>

Petitioner contends, thus, that its failure to act was due to circumstances outside its reasonable control and, thus, due to excusable neglect.

Petitioner requests that the discovery period and its testimony period be reopened and all subsequent dates be reset. In addition, petitioner informs the Board that after the filing of the first petition to cancel but before the filing of the second, duplicate petition to cancel, respondent filed its combined Trademark Act §§8 and 15 affidavit, accepted and acknowledged by the Office, for Registration No. 2360169 (MICHELANGELO). Petitioner asks that the acceptance and acknowledgement be withdrawn. Petitioner also informs the Board that Registration No. 2290867 (ELF DEEPDENE) was cancelled for failure to file a Trademark Act §8 affidavit after commencement of the instant cancellation proceeding. Petitioner asks that the proceeding be dismissed as moot with respect to Registration No. 2290867.

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Trademark Rule 2.132(a) provides that when the party in the position of plaintiff fails to take testimony during the time allowed, judgment may be entered against it in the absence of a showing of good and sufficient cause. The "good and sufficient cause" standard, in the context of this rule, is equivalent to the "excusable neglect" standard, which would have to be met by any motion under Fed. R. Civ. P. 6(b)(2) to reopen the plaintiff's testimony period. *See Grobet File Co. of America Inc. v. Associated Distributors Inc.*, 12 USPQ2d 1649 (TTAB 1989); and *Fort Howard Paper Co. v. Kimberly-Clark Corp.*, 216 USPQ 617 (TTAB 1982). *See also* TBMP §534 (2d ed. rev. 2004).

In *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership*, 507 U.S. 380 (1993), as discussed by the Board in *Pumpkin, Ltd. v. The Seeds Corps.*, 43 USPQ2d 1582 (TTAB 1997), the Supreme Court clarified the meaning and scope of "excusable neglect," as used in the Federal Rules of Civil Procedure and elsewhere. The Court held that the determination of whether a party's neglect is excusable is "at bottom an equitable one, taking account of all relevant circumstances surrounding the party's omission. These include ... [1] the danger of prejudice to the [nonmovant], [2] the length of the delay and its potential impact on judicial proceedings, [3] the reason for the delay, including whether it was within the reasonable control

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<sup>3</sup> At that time, petitioner's attorney was advised that neither principal of respondent had informed respondent's outside counsel that the principals had been involved in settlement discussions.



of the movant, and [4] whether the movant acted in good faith." *Pioneer*, 507 U.S. at 395. In subsequent applications of this test by the Circuit Courts of Appeal, several courts have stated that the third factor must be considered the most important factor in a particular case. See *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1586 at fn.7 (TTAB 1997). It is true that this does not mean that the standard will be applied restrictively or that the movant's conduct must be faultless. See *Wright & Miller*, 4B Fed. Prac. & Pro. Civ.3d §1165 (2007). However, the party seeking the enlargement of time must present facts demonstrating excusable neglect, including that its failure to act was not due to circumstances within its reasonable control.

We look first at the first, second and fourth *Pioneer* factors. Except for the delay occasioned herein, there does not appear to be any measurable prejudice to respondent should the Board grant a reopening of the discovery period and reset the testimony periods. Respondent has made no showing of lost evidence or unavailable witnesses. Respondent will bear no significantly greater cost in defending this matter than it would have if petitioner had properly presented its case. See *HGK Industries, Inc. v. Perma-Pipe, Inc.*, 49 USPQ2d 1156 (TTAB 1998). In the meantime, respondent's registrations remain registered. The length of delay and impact to this proceeding are not inconsequential, however. There is no evidence that petitioner is acting in bad faith.

We consider next the third *Pioneer* factor, the circumstances attributed to the delay. Petitioner's activities of engaging in settlement discussions and responding to respondent's discovery requests prior to the relocation of its attorney show petitioner's active interest in the case. However, such circumstances, and the cessation of activities just prior to the relocation of petitioner's attorney, are all within the reasonable control of petitioner, including petitioner's decision to defer serving its own discovery requests believing that settlement would occur. See *Atlanta-Fulton County Zoo, Inc. v. De Palma*, 45 USPQ2d 1858 (TTAB 1998) (mere existence of settlement negotiations did not justify party's inaction or delay). Cf. *American Vitamin Products, Inc. v. Dow Brands, Inc.*, 22 USPQ2d 1313 (TTAB 1992) (desire to take follow up discovery does not excuse failure to file a timely motion to extend discovery).

The Board notes that the relocation of petitioner's attorney's legal business *per se* does not give rise to excusable neglect. See *Pioneer Investment Services*, 507 U.S. at 398 ("...we give little weight to the fact that counsel was experiencing upheaval in his law practice at the time ..."). Cf. *In re William B. Kessler, Inc.*, 29 B.R. 358, 359 (Bankr. S.D.N.Y. 1983) (excusable neglect found where confusion and relocation of a law office as well as the serious illness of the partner in charge at the time). Thus, the Board must look at the circumstances

arising from the relocation of petitioner's attorney, which include the unexpected systems failures and other construction delays resulting in corruption of the databases notwithstanding "repair."

Petitioner's attorney states he moved his office on May 25, 2006 and experienced construction delays and technical problems over the next thirty-five days and that the technical failures required repairs and reconstitution of data. Thus, the problems encountered took place between the end of May and the beginning of July 2006. However, petitioner fails to explain what transpired subsequent to the thirty-five days over which the move occurred that prevented petitioner from acting. The discovery period remained open until September 18, 2006, at least two months after the move period, and petitioner's testimony period closed December 18, 2006, at least five months after the move period. Petitioner's attorney has not explained what was done in advance of his move to back up his active files and calendar. No information has been provided as to what steps were taken after the move to ascertain if the records in question were completely reconstituted, especially since it is acknowledged that "errors arose" by virtue of the corrupted systems. No information has been provided as to what steps were taken subsequent to the repairs to find out what files remained corrupted and to minimize the effects of lost data in view of the recognition that "errors arose" during the move. For example, no mention has been made of

whether paper records were kept for active files and what happened to the hard copy of the Board's March 3, 2006 institution order setting all dates or whether petitioner or its attorney attempted to ascertain the status of pending matters by availing themselves of the USPTO's electronic systems.

It must be remembered that a plaintiff's failure to take testimony in Board proceedings is analogous to not showing up in court on the day of trial. In *Old Nutfield Brewing Company v. Hudson Valley Brewing Co.*, 65 USPQ2d 1701 (TTAB 2002), no excusable neglect was found for the plaintiff's failure to take testimony and the plaintiff's motion to reopen its testimony period was denied. There was no question that the plaintiff knew about the proceeding. The plaintiff relied upon its failure to receive a copy of the defendant's answer and the parties' engagement in settlement discussions to excuse its failure to take testimony. However, plaintiff chose not to ascertain the status of the case until after its testimony period closed. The Board reminded the plaintiff that there are several avenues for ascertaining status of Board proceedings including the then-existing BISX information system maintained by the USPTO.

The Board has revised its status information database in recent years. BISX has been replaced with TTABVUE.<sup>4</sup> In addition to the proceeding number, application number, and registration

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<sup>4</sup> TTABVUE is accessible at <http://ttabvue.uspto.gov/ttabvue/> and from the USPTO's home page, [www.uspto.gov](http://www.uspto.gov) through numerous links, including "ebusiness."

number, status may be ascertained using various other search terms, including the name of any party, the name of the correspondent (attorney of record where applicable) and the name of the mark. This is an easy to use and free database maintained by the USPTO. It is urged that the status of Board proceedings be checked regularly by the parties and their attorneys using this system. Any party or practitioner experiencing a relocation or technical failures may avoid or minimize a situation such as that presented here if advantage is taken of the TTABVue information system.

In sum, though the Board has sympathy for petitioner and its attorney regarding the disruptions caused by the systems failures, insufficient information has been provided for the Board to conclude that the file for this case was permanently lost from the systems of petitioner's attorney and that steps taken to back up and retrieve the records without success during and after the move. Based on these circumstances of facts, we cannot find excusable neglect so as to warrant a reopening of petitioner's testimony period. Accordingly, petitioner's request to reopen the discovery and testimony periods is denied.

Insofar as Registration No. 2290867 (ELF DEEPDENE) was cancelled for failure to file a Trademark Act §8 affidavit after commencement of the instant cancellation proceeding, petitioner's request that this proceeding be dismissed as moot with respect to

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such registration is granted. See Trademark Rule 2.134(b), 37 C.F.R. 2.134(b); and TBMP §535 (2d ed. rev. 2004). The petition to cancel is hereby dismissed as moot as to Registration No. 2290867.

Petitioner has taken no testimony and has offered no evidence of record upon which it may rely to prove its case. Accordingly, as to Registration Nos. 2289874 (EFL KENNERLY), 2360169 (MICHELANGELO) and 2624424 (MICHELANGELO), respondent's motion for involuntary dismissal is granted, and the petition to cancel is dismissed with prejudice.<sup>5</sup>

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<sup>5</sup> In view of the dismissal, petitioner's request that the USPTO's acceptance and acknowledgement of respondent's combined Sections 8 and 15 affidavit for Registration No. 2360169 be withdrawn is denied.